Serial No.:	09/709,433	**Conf. No.:**	4323
Filing Date:	11/13/2000	**Art Unit:**	2178
Applicants:	Stewart et al.	**Examiner:**	Campbell, Joshua D.
Title:	SYSTEM, METHOD AND RECORDABLE MEDIUM FOR PRINTING SERVICES OVER A NETWORK AND GRAPHICAL USER INTERFACE	**Docket No.:**	424992000200 (MIME-0003)

Mail Stop Appeal Brief- Patents
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REPLY BRIEF OF APPELLANTS

This is a reply brief, which is being filed in response to the Examiner's Answer dated 28 November 2006 to address new evidence made of record and new clarifications to the Examiner's position presented in the Examiner's Answer.

REMARKS

A. Response to Arguments with respect to claim 12

In responding to Appellants' arguments with respect to claim 12, the Examiner presents different arguments from those presented in the rejection of claim 12 (Examiner's Answer, p. 3). In particular, the Examiner states that

> the converted printable electronic document that is used to generate the preview is the finished converted version of the original document, which meets the user's configuration for what the final hard-copy document will look like (column 5, lines 46-column 6, lines 23 of Adamske). Thus, the print preview that is generated is clearly based on the print file and the configuration information...

Examiner's Answer, p. 12, lines 2-5. Here, the Examiner apparently alleges that the converted printable electronic document of Adamske corresponds to both the claimed print file and configuration information. However, Appellants note that in the claimed invention, the configuration information is obtained on the server separately from the print file. To this extent, in generating a preview of a configured copy of the document, the claimed invention requires use of both a print file and configuration information, which have been separately obtained at the server. Appellants reiterate that Adamske fails to disclose obtaining any information used in generating the preview apart from the converted printable electronic document. As a result, even under the alternative interpretation of Adamske, the Examiner fails to present a *prima facie* showing of obviousness.

Additionally, the Examiner states that "Adamske even teaches that the user may change the configuration of the document after viewing the preview... thus clearly showing that the preview is based on the document and the configuration information." Appellants note that Adamske does not mention "chang[ing] the configuration of the document", but rather states that "user 10 can make changes to the electronic document". Adamske, col. 3, lines 66-67. Further, the claimed invention generates a preview based on a print file and configuration information,

not "based on the document and configuration information" as stated by the Examiner. As a result, the Examiner's arguments are not relevant to the claimed invention.

The Examiner also alleges that "appellant argues that the user may select certain print options after the print preview is verified...", and states that such features "are not recited in the rejected claim(s)." Examiner's Answer, p. 12, lines 14-19. Appellants submit that the Examiner apparently misinterprets Appellants' arguments. In particular, this discussion addresses the Examiner's previous response to Appellants' arguments in the Final Rejection, in which the Examiner alleges that Adamske allows a user to "chang[e] configuration options such as black and white or color printing which could then be incorporated into the new preview". Final Rejection, p. 12, lines 12-16. The discussion explains the express teachings of Adamske, which differ from the Examiner's assertion, and is otherwise unrelated to an interpretation of Appellants' claimed invention.

B. Response to Arguments with respect to claim 20

1. Interpretations of Adamske by the Examiner

In responding to Appellants' arguments with respect to claim 20, the Examiner introduces a paper on GNU's Ghostscript software ("Ghostscript") in support of maintaining the rejection and alleges that the paper "lays to rest the arguments the appellant has set forth based on the incorrect interpretation of the Adamske reference's disclosure and invention." Examiner's Answer, pp. 14-15. Appellants strongly disagree with the Examiner and submit that the paper provides further support for Appellants' interpretation of Adamske.

In the web-based embodiment of Adamske, the print preview software program converts a converted printable electronic document (e.g., a PostScript file) into a series of graphical

preview images (e.g., JPEG images). Adamske, col. 5, line 64 – col. 6, line 8. Ghostscript states that it can interpret a PostScript file into one or more page bitmaps. The Examiner relies on these teachings and the statement that the print driver program in the client-based embodiment "includes all of the functionality of the print preview software program" (Adamske, col. 6, lines 43-44) as conclusive evidence that the print driver program in Adamske's client-based embodiment creates a PostScript file.

However, in forming this conclusion, the Examiner ignores express statements in Adamske with respect to the client-side embodiment. In particular, the Examiner ignores the fact that the print driver program "accesses the client application and creates a metafile from the electronic document." Adamske, col. 6, lines 44-47. This functionality is not disclosed in either the web-based embodiment of the print preview software program or in Ghostscript. In fact, in the web-based embodiment, Adamske includes this functionality in a conversion program on an application translation server. Adamske, col. 5, lines 21-46. As a result, the print driver program in the client-based embodiment must be something other than just the Ghostscript software as implied by the Office. Additionally, in the client-side embodiment, Adamske states that the metafile is converted "into a printable (e.g., PostScript) version" on the translation server. Adamske, col. 6, lines 49-52. As a result, the metafile is clearly something other than a PostScript file, the only file that Ghostscript processes. In light of this, Appellants maintain that the "same functionality" is limited to providing a print preview.

Additionally, the Examiner further errs in relying on specific functionality of Ghostscript in support of its rejection. In particular, the Examiner alleges that JPEG images and page bitmaps generated by Ghostscript can be directly printed by a printer. Apparently, the Examiner maintains that these files teach the claimed print file, which is communicated to a server.

However, Appellants note that Adamske never discloses that either of these types of files are ever provided to a server in the client-based embodiment. In sharp contrast, in the client-based embodiment, if such files are generated, they are only displayed on the client computer. Adamske states that a metafile is sent "to translation server 24... and the conversion into a printable (e.g., PostScript) version is performed..." Adamske, col. 6, lines 49-52.

2. Motivation for Modifications to Adamske

In responding to Appellants' arguments with respect to the cited motivation to modify Adamske to arrive at Appellants' claimed invention, the Examiner states that

> the fact that the secondary reference (first embodiment) teaches that moving some of the functionality to the server from the client would in fact reduce the processing load at the client... provides exactly the motivation necessary to make this combination because this combination would provide an improvement to the first reference (second embodiment) which is reducing processing load at the client.

Examiner's Answer, p. 17, lines 11-17. Appellants and the Examiner agree that neither the web-based nor the client-side embodiments of Adamske alone teaches all the claimed limitations. Additionally, the Examiner acknowledges that Adamske's web-based embodiment addresses the motivation cited by the Examiner to modify Adamske's client-side embodiment. Based on this, it logically follows that Adamske expressly provides a solution that addresses the cited motivation using an alternative solution to Appellants' claimed invention. Appellants maintain that Adamske's inclusion of the alternative solution clearly teaches away from Appellants' claimed invention. However, the Examiner maintains that it is this fact that "provides exactly the motivation" to arrive at Appellants' claimed invention. Appellants strongly disagree. In fact, absent the hindsight of Appellants' invention, the motivation is clearly addressed by the express teachings of Adamske.

C. Conclusion

In summary, Appellants maintain that claims 12-33 are allowable because Adamske, taken alone or in combination with Bresnan, fails to meet each of the three basic criteria required to establish a *prima facie* case of obviousness.

Respectfully submitted,

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